

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:	)	
	)	
Craig NEVILL-MANNING	)	Group Art Unit: 2166
	)	
Application No.: 10/608,270	)	Examiner: Joon H. Hwang
	)	
Filed: June 27, 2003	)	
	)	
For: SYSTEM AND METHOD FOR	)	
PROVIDING DEFINITIONS	)	

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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Applicant respectfully requests review of the final Office Action, dated, August 27, 2007, in view of the Remarks below and in conjunction with the Notice of Appeal filed concurrently with this request.

Claims 1-4, 6-14, 17-26, 28-36, 39-44, 46-58, and 60 are pending in this application. The Examiner finally rejects claims 1-4, 6, 8-9, 13-14, 17, 23-26, 28, 30-31, 35-36, 39, 46-49, 52-55, 58, and 60 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2004/0249801 (hereinafter "KAPUR") in view of U.S. Publication No. 2005/0234709 (hereinafter "KLAVANS"); rejects claims 7 and 29 under 35 U.S.C. § 103(a) as being unpatentable over KAPUR in view of KLAVANS, and further in view of "How to get a site listed in Google Glossary?", internet citation, 1/30/2003 (hereinafter "MAURER"); rejects claims 10-12, 32-34, 50, and 56 under 35 U.S.C. § 103(a) as being unpatentable over KAPUR in view of KLAVANS, and further in view of U.S. Publication No. 2004/0073541 (hereinafter "LINDBLAD"); rejects claims 18-19 and 40-41 under 35 U.S.C. § 103(a) as being unpatentable over KAPUR in view of KLAVANS, and further in view of U.S. Patent No. 6,922,809 (hereinafter "CODEN"); and rejects claims 20-22, 42-44, 51, and 57 under 35 U.S.C. § 103(a) as being unpatentable over KAPUR in view of KLAVANS, and further in view of U.S. Patent No. 6,701,309 (hereinafter "BEEFERMAN"). Applicant submits that the Examiner's rejections are incomplete and based on errors in fact.

The rejection of claims 1-4, 6, 8-9, 13-14, 17, 23-26, 28, 30-31, 35-36, 39, 46-49, 52-55, 58, and 60 contains factual deficiencies with respect to the alleged teachings of KAPUR and KLAVANS. For

example, each of independent claims 1, 23, 46, 47, 53 and 60 includes features that are clearly not disclosed or suggested by KAPUR and KLAVANS, whether taken alone or in any reasonable combination. For example, as to claim 1, KAPUR and KLAVANS do not disclose or suggest a user interface configured to present one or more definitions for a phrase in an order determined based on a ranking of documents that contain the presented one or more definitions (see, for example, the arguments at pp. 3-4 of the Request for Reconsideration response filed October 29, 2007 (hereinafter "Response").

The Examiner relies on paragraphs [0025] and [0176] of KAPUR, as well as Fig. 8 of KAPUR for allegedly disclosing the above feature (final Office Action, p. 4). Paragraph [0025] of KAPUR discloses a server configured with search algorithms for classifying and ranking web pages. This section of KAPUR does not disclose documents containing definitions. Nor does this section disclose a user interface. Therefore, this section of KAPUR cannot disclose or suggest a user interface configured to present one or more definitions for a phrase in an order determined based on a ranking of documents that contain the presented one or more definitions, as recited in claim 1 (see, for example, arguments at p. 3 of the Response).

Paragraph [0176] and Fig. 8 of KAPUR do not find support in U.S. Provisional Application No. 60/460,222 (hereinafter "Provisional Application"), to which KAPUR claims priority. Applicant notes that the filing date of KAPUR is April 5, 2004, which is after Applicant's filing date of June 27, 2003. Thus, paragraph [0176] and Fig. 8 of KAPUR are not prior art with respect to the present application and cannot be relied on in a rejection of Applicant's claim 1 (see, for example, arguments at p. 4 of the Response).

In the Advisory Action dated November 16, 2007, the Examiner relies on p. 14, section 41; p. 15, section 42; p. 2, section 17; p. 17, section 46; p. 16, paragraph 6; p. 15, paragraph 6; p. 26, paragraph 4; and p. 19, paragraphs 7-10 of the Provisional Application for allegedly providing support for the subject matter of Fig. 8 and paragraph [0176] of KAPUR. At the outset, Applicant submits that the subject matter of Fig. 8, and of paragraph [0176] (which describes Fig. 8) of KAPUR is not present in the Provisional Application.

P. 14, section 41 and p. 15, section 42 of the Provisional Application disclose a universal dialog box. P. 15, section 42; p. 2, section 7; p. 17, section 46; p. 15, paragraph 6; and p. 26, paragraph 4 of the Provisional Application disclose examples of using the universal dialog box. None of these sections of the Provisional Application even mention definitions.

P. 26, paragraph 4 of the Provisional Application discloses that "postal rates, zip codes, thesaurus, dictionary, encyclopedia, spell-checking, yellow pages, white pages, reverse phone number lookup, tv show schedules, movie schedules, etc. will also be available through the universal dialog box." This section of the Provisional Application does not disclose or suggest any ranking of documents that

contain definitions. Therefore, this section of the Provisional Application cannot disclose or suggest a user interface configured to present one or more definitions for a phrase in an order determined based on ranking of documents that contain the presented one or more definitions, as recited in claim 1.

KLAVANS does not overcome the deficiencies of KAPUR set forth above with respect to claim 1.

Thus, the Examiner's allegations on pp. 4-5 of the final Office Action and in the Advisory Action dated November 16, 2007 are insufficient for establishing a *prima facie* case of obviousness with respect to claim 1. For at least the foregoing reasons, Applicant respectfully requests that the rejection of claim 1 under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

Claims 2-4, 6, 8-9, 13-14, and 17 depend from claim 1. Therefore, these claims are patentable over KAPUR and KLAVANS for at least the reasons set forth above with respect to claim 1.

Independent claim 23 recites features similar to, yet possibly of different scope than, the features recited above with respect to claim 1. Therefore, this claim is patentable over KAPUR and KLAVANS for at least the reasons set forth above with respect to claim 1.

Claims 24-26, 28, 30-31, 35-36, and 39 depend from claim 23. Therefore, these claims are patentable over KAPUR and KLAVANS for at least the reasons set forth above with respect to claim 23.

Independent claim 46 recites features similar to, yet possibly of different scope than, the features recited above with respect to claim 1. Therefore, this claim is patentable over KAPUR and KLAVANS for at least the reasons set forth above with respect to claim 1.

As to independent claim 47, see, for example, the arguments at pp. 5-7 of the Response. The Examiner again relies on paragraph [0025] of KAPUR (which does not disclose definitions) and on paragraph [0176] and Fig. 8 of KAPUR, which do not find support in the Provisional Application and therefore cannot be relied upon as prior art in a rejection of claim 47. Additionally, the Provisional Application does not disclose or suggest a search front end matching a phrase for which a definition is sought against stored information for each identified document, returning one or more matching definitions based on the matching of the phrase, and presenting each matching definition in an order determined based on a ranking of the documents that contain the presented one or more definitions, as recited in claim 47.

Thus, the Examiner's allegations on pp. 8-10 of the final Office Action and in the Advisory Action dated November 16, 2007 are insufficient for establishing a *prima facie* case of obviousness with respect to claim 47. For at least the foregoing reasons, Applicant respectfully requests that the rejection of claim 47 under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

Claims 48-49 and 52 depend from claim 47. Therefore, these claims are patentable over KAPUR and KLAVANS for at least the reasons set forth above with respect to claim 47.

Independent claims 53 and 60 recites features similar to, yet possibly of different scope than, the features recited above with respect to claim 47. Therefore, these claims are patentable over KAPUR and KLAVANS for at least the reasons set forth above with respect to claim 47.

Claims 54-55 and 58 depend from claim 53. Therefore, these claims are patentable over KAPUR and KLAVANS for at least the reasons set forth above with respect to claim 53.

The rejection of claims 7 and 29 under 35 U.S.C. § 103(a) based on KAPUR, KLAVANS, and MAUER should be withdrawn.

Claim 7 depends from claim 1. MAUER does not remedy the deficiencies of KAPUR and KLAVANS set forth above with respect to claim 1. Therefore, this claim is patentable over KAPUR, KLAVANS, and MAUER for at least the reasons set forth above with respect to claim 1.

Claim 29 depends from claim 23. MAUER does not remedy the deficiencies of KAPUR and KLAVANS set forth above with respect to claim 23. Therefore, this claim is patentable over KAPUR, KLAVANS, and MAUER for at least the reasons set forth above with respect to claim 23.

The rejection of claims 10-12, 32-34, 50, and 56 under 35 U.S.C. § 103(a) based on KAPUR, KLAVANS, and LINDBLAD should be withdrawn.

Claims 10-12 depend from claim 1. LINDBLAD does not remedy the deficiencies of KAPUR and KLAVANS set forth above with respect to claim 1. Therefore, these claims are patentable over KAPUR, KLAVANS, and LINDBLAD for at least the reasons set forth above with respect to claim 1.

Claims 32-34 depend from claim 23. LINDBLAD does not overcome the deficiencies of KAPUR and KLAVANS set forth above with respect to claim 23. Therefore, these claims are patentable over KAPUR, KLAVANS, and LINDBLAD, for at least the reasons set forth above with respect to claim 23.

Claim 50 depends from claim 47. LINDBLAD does not overcome the deficiencies of KAPUR and KLAVANS set forth above with respect to claim 47. Therefore, this claim is patentable over KAPUR, KLAVANS, and LINDBLAD, for at least the reasons set forth above with respect to claim 47.

Claim 56 depends from claim 53. LINDBLAD does not overcome the deficiencies of KAPUR and KLAVANS set forth above with respect to claim 53. Therefore, this claim is patentable over KAPUR, KLAVANS, and LINDBLAD, for at least the reasons set forth above with respect to claim 53.

The rejection of claims 18-19 and 40-41 under 35 U.S.C. § 103(a) based on KAPUR, KLAVANS, and CODEN should be withdrawn.

Claims 18-19 depend from claim 1. CODEN does not overcome the deficiencies of KAPUR and KLAVANS set forth above with respect to claim 1. Therefore, these claims are patentable over KAPUR, KLAVANS, and CODEN, for at least the reasons set forth above with respect to claim 1.

Claims 40-41 depend from claim 23. CODEN does not overcome the deficiencies of KAPUR and KLAVANS set forth above with respect to claim 23. Therefore, these claims are patentable over KAPUR, KLAVANS, and CODEN, for at least the reasons set forth above with respect to claim 23.

The rejection of claims 20-22, 42-44, 51, and 57 under 35 U.S.C. § 103(a) based on KAPUR, KLAVANS, and BEEFERMAN should be withdrawn.

Claims 20-22 depend from claim 1. BEEFERMAN does not overcome the deficiencies of KAPUR and KLAVANS set forth above with respect to claim 1. Therefore, these claims are patentable over KAPUR, KLAVANS, and BEEFERMAN, for at least the reasons set forth above with respect to claim 1.

Claims 42-44 depend from claim 23. BEEFERMAN does not overcome the deficiencies of KAPUR and KLAVANS set forth above with respect to claim 23. Therefore, these claims are patentable over KAPUR, KLAVANS, and BEEFERMAN, for at least the reasons set forth above with respect to claim 23.

Claim 51 depends from claim 47. BEEFERMAN does not overcome the deficiencies of KAPUR and KLAVANS set forth above with respect to claim 47. Therefore, these claims are patentable over KAPUR, KLAVANS, and BEEFERMAN, for at least the reasons set forth above with respect to claim 47.

Claim 57 depends from claim 53. BEEFERMAN does not overcome the deficiencies of KAPUR and KLAVANS with respect to claim 53. Therefore, these claims are patentable KAPUR, KLAVANS, and BEEFERMAN, for at least the reasons set forth above with respect to claim 53.

In view of the foregoing remarks, Applicants submit that clear factual deficiencies exist with respect to the rejections of claims 1-4, 6-14, 17-26, 28-36, 39-44, 46-58, and 60. Therefore, Applicants respectfully request withdrawal of the outstanding rejections and the timely allowance of this application.

Respectfully submitted,  
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